

## TRANSMITTAL FORM

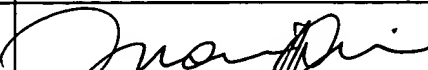
(to be used for all correspondence after initial filing)

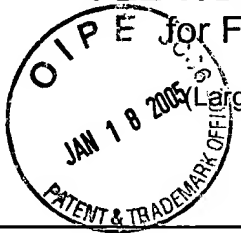
	Complete if Known	
	Application No.	09/734,043
	Filing Date	December 12, 2000
	First Named Inventor	Matthew W. Mengerink et al.
	Group Art Unit	2151
	Examiner Name	Hassan A. Phillips
Total Number of Pages in This Submission <u>21</u>	Attorney Docket No.	2766-101
	Customer No.	6449
ENCLOSURES (check all that apply)	Confirmation No.	3510

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|--|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form                     | <input type="checkbox"/> Assignment Papers  | <input type="checkbox"/> After Allowance Communication to Group                                       |
| <input checked="" type="checkbox"/> Fee Attached                             | <input type="checkbox"/> Drawing(s)   | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences                   |
| <input type="checkbox"/> Amendment/Reply                                     | <input type="checkbox"/> Licensing-related Papers                                       | <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final   | <input type="checkbox"/> Petition   | <input type="checkbox"/> Proprietary Information  |
| <input type="checkbox"/> Affidavits/declaration(s)                           | <input type="checkbox"/> Petition to Convert to a Provisional Application               | <input type="checkbox"/> Status Letter  |
| <input type="checkbox"/> Extension of Time Request                           | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input type="checkbox"/> Other Enclosure(s) (please identify below):                                  |
| <input type="checkbox"/> Express Abandonment Request                         | <input type="checkbox"/> Terminal Disclaimer  |   |
| <input type="checkbox"/> Information Disclosure Statement                    | <input type="checkbox"/> Request for Refund   |   |
| <input type="checkbox"/> Certified Copy of Priority Document(s)              | <input type="checkbox"/> CD, Number of CD(s)  |   |
| <input type="checkbox"/> Response to Missing Parts/Incomplete Application    |   |   |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 |   |   |

REMARKS:

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SUBMITTED BY		Complete (if applicable)			
NAME AND REG. NUMBER	Monica S. Davis, Reg. No. 44,492				
SIGNATURE		DATE	January 18, 2005	DEPOSIT ACCT USER ID	02-2135

<b>FEE TRANSMITTAL</b> for FY 2005 (Large Entity) 		Complete if Known	
		Application Number	09/734,043
		Filing Date	December 12, 2000
		First Named Inventor	Matthew W. Mengerink et al.
		Examiner Name	Hassan A. Phillips
		Group Art Unit	2151
<input type="checkbox"/> Applicant claims small entity status		Attorney Docket Number	2766-101
Total Amount of Payment	(\$) <b>500.00</b>	Confirmation Number	3510

**METHOD OF PAYMENT** (check one)

1. ☒ The Commissioner is hereby authorized to charge the fees indicated below or credit overpayment to Deposit Account Number 02-2135 in the name of Rothwell, Figg, Ernst & Manbeck
- ☒ Charge any additional fee required under 37 CFR 1.16 and 1.17 to Deposit Account No. 02-2135.
2. ☒ Payment by check enclosed

**FEE CALCULATION**
**1. FILING, SEARCH AND EXAMINATION FEES**

Code	Fee	Fee Description	Fee Paid
1001	300	Utility Filing Fee	[ ]
1111	500	Utility Search Fee	[ ]
1311	200	Utility Examination Fee	[ ]
1002	200	Design Filing Fee	[ ]
1112	100	Design Search Fee	[ ]
1312	130	Design Examination Fee	[ ]
1003	200	Plant Filing Fee	[ ]
1113	300	Plant Search Fee	[ ]
1313	160	Plant Examination Fee	[ ]
1004	300	Reissue Filing Fee	[ ]
1114	500	Reissue Search Filing Fee	[ ]
1314	600	Reissue Examination Fee	[ ]
1005	200	Provisional Filing Fee	[ ]

**SUBTOTAL \$**
**2. CLAIMS**

Total Claims	Independent Claims	Multiple Dependent Claims	Extra Claims	Fee	Fee Paid
[ ]	[ ]	[ ]	- 20* = [ ] x	\$50 = [ ]	[ ]
[ ]	[ ]	[ ]	- 3* = [ ] x	200 = [ ]	[ ]
[ ]	[ ]	[ ]	+ 360 = [ ]		[ ]

\*or number previously paid, if greater

**SUBTOTAL \$**
**3. APPLICATION SIZE FEE**

Total Sheets [ ] - 100 = [ ] / 50 = [ ]\*\* x \$250 =

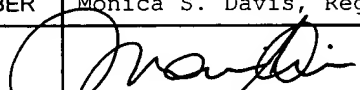
\*\* Number of each additional 50 or fraction thereof

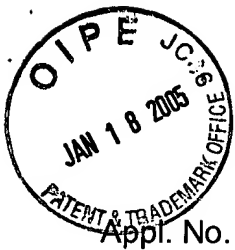
**SUBTOTAL \$**
**FEE CALCULATION** (continued)

**4. ADDITIONAL FEES**

Code	Fee	Fee Description	Fee Paid
1051	130	Surcharge - late filing fee or oath	[ ]
1052	50	Surcharge - late provisional filing fee or cover sheet	[ ]
1053	130	Non-English specification	[ ]
1812	2,520	For filing a request for reexamination	[ ]
1804	920	Requesting publication of SIR prior to Examiner action	[ ]
1805	1,840	Requesting publication of SIR after Examiner action (reduced by basic filing fee paid)	[ ]
1251	120	Extension for reply within first month	[ ]
1252	450	Extension for reply within second month	[ ]
1253	1,020	Extension for reply within third month	[ ]
1254	1,590	Extension for reply within fourth month	[ ]
1255	2,160	Extension for reply within fifth month	[ ]
1401	500	Notice of Appeal	[ ]
1402	500	Filing a brief in support of an appeal	[500.00]
1403	1,000	Request for Oral Hearing	[ ]
1451	1,510	Petition to institute a public use proceeding	[ ]
1452	500	Petition to revive -unavoidable	[ ]
1453	1,500	Petition to revive - unintentional	[ ]
1807	50	Processing fee under 37 CFR 1.17(q)	[ ]
1806	180	Submission of Information Disclosure Statement	[ ]
1809	790	Filing a submission after final rejection (37 CFR .129(a))	[ ]
1810	790	For each additional invention to be examined (37 CFR 1.129(b))	[ ]
1801	790	Request for Continued Examination (RCE)	[ ]
1802	900	Request for expedited examination of a design application	[ ]
1504	300	Publication fee for early, voluntary, or normal publication	[ ]
1505	300	Publication fee for republication	[ ]
1455	200	Filing application for patent term adjustment	[ ]
1456	400	Request for reinstatement of term reduced	[ ]
1814	130	Statutory Disclaimer	[ ]
Other fee (specify)			[ ]

**SUBTOTAL \$500.00**

SUBMITTED BY		Complete (if applicable)			
NAME AND REG. NUMBER		Monica S. Davis, Reg. No. 44,492			
SIGNATURE		DATE	January 18, 2005	DEPOSIT ACCOUNT USER ID	



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/734,043  
Applicant : Matthew W. MENDERINK et al.  
Filed : December 12, 2000  
TC/A.U. : 2151  
Examiner : Hassan A. Phillips  
  
Docket No. : 2766-101  
Customer No. : 06449  
Confirmation No. : 3510

Director of the United States Patent  
and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37**

Sir:

The following comprises the Appellants' Brief on Appeal from the final rejection, dated July 14, 2004, of claims 1-16. This Appeal Brief is accompanied by the required appeal fee set forth in 37 C.F.R. § 1.17(c). Appellants' Notice of Appeal was filed on November 15, 2004. Therefore, the present Appeal Brief is timely filed.

**I. REAL PARTY IN INTEREST**

The above-captioned application is assigned in its entirety to Google, Inc., which is the real party in interest.

**II. RELATED APPEALS AND INTERFERENCES**

Appellants state that, upon information and belief, they are not aware of any co-pending appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

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### III. STATUS OF CLAIMS

This is an appeal from the final rejection dated July 14, 2004, wherein claims 1, 3, 4, 6-8 and 10-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Fleskes (U.S. Patent No. 6,529,910). Claims 2, 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fleskes in view of Hickman (U.S. Patent Publication No. 2001/0033564). Claims 13-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fleskes.

The present application was originally filed with claims 1-12. An Amendment under 37 C.F.R. § 1.111 was filed May 24, 2004 amending claims 1 and 8, and adding claims 13-16. Accordingly, claims 1-16 are the claims currently on appeal.

### IV. STATUS OF AMENDMENTS

All Amendments have been considered and entered.

### V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention will be summarized by reading the appealed claims onto the specification and drawings. See MPEP § 1206, at 1200-10.

Appellants' invention provides a system (FIG. 1) for allowing a user to customize a personal web page using an Internet web site having predetermined features that can be incorporated into the personal web page, as set forth in independent claim 1. A server (FIG. 1: 100) is connected to the Internet (FIG. 1: 160) and controls the web site. Page 5, lines 2-9. A web page-forming component (FIG. 1: 110) forms the personal web page incorporating one or more of the features of the web site in response to an input provided by the user via the Internet (FIG. 1: 160). Page 5, lines 22-32. The personal web page comprises a private component accessible only by the user and a public component accessible to anyone. Page 6, lines 17-20. The user's input

determines which of the features appear in the private component and which of the features appear in the public component. Page 6, lines 20-26.

As recited in dependent claim 2, the invention is further embodied in a system as described above in which the input further provides biographical information on the user to be included in the public component. Page 11, lines 17-20.

As recited in dependent claim 3, the invention is further embodied in a system as described above which also comprises a single action construction component (FIG. 1: 140). The user may add one or more of the web site features to the personal web page with a single action. Page 9, line 27-page 10, line 4.

As recited in dependent claim 4, the invention is further embodied in a system as described above which also comprises an annotation component (FIG. 1: 150) that allows the user to create and store a comment related to one of the features in the personal web page, such that the comment may be later accessed. Page 8, line 30-page 9, line 21.

As recited in dependent claim 5, the invention is further embodied in a system as described above in which the server (FIG. 1: 100) allows a third party to access the public component from the web site in a single action. Page 6, lines 17-20.

As recited in dependent claim 6, the invention is further embodied in a system as described above in which the web page-forming component (FIG. 1: 110) further comprises a construction component (FIG. 1: 170) to guide the user through the formation of the personal site. Page 8, lines 22-29.

As recited in dependent claim 7, the invention is further embodied in a system as described above which also comprises a tracking component (FIG. 1: 180) that changes the personal web page to reflect changes in the web site. Page 10, line 15-page 11, line 2.

As recited in independent claim 8, another aspect of the invention is embodied in a method (FIG. 2.) for allowing a user to customize an Internet web site having

particular features. Access is provided to a web site via a server (FIG. 1: 100). FIG. 2: 200; page 11, lines 5-6. In response to receiving an input to the website, a web page-forming component (FIG. 1: 110) for forming a personal web page incorporating one or more of the web site features in accordance with the input is provided. FIG. 2: 210; page 11, lines 6-16. The personal web page comprises a private component accessible only by the user and a public component accessible to anyone. Page 6, lines 17-20. The input determines which of the features appear in the private component and which of the features appear in the public component. Page 6, lines 20-26.

As recited in dependent claim 9, the invention is further embodied in a method as described above which also comprises providing biographical information to be included in the public component. FIG. 2: 220; page 11, lines 17-20.

As recited in dependent claim 10, the invention is further embodied in a method as described above which also comprises adding one of the web site features to the personal web page with a single action. FIG. 2: 230; page 9, line 27-page 10, line 4; page 11, lines 21-24.

As recited in dependent claim 11, the invention is further embodied in a method as described above which also comprises creating an annotation related to one of the features in the personal web page (FIG. 2: 250), storing the annotation (FIG. 2: 260), and accessing the annotation during subsequent use of the personal web page (FIG. 2: 270). FIG. 2: 240; page 8, line 30-page 9, line 21; page 11, lines 25-30.

As recited in dependent claim 12, the invention is further embodied in a method as described above which also comprises automatically updating the personal web page. FIG. 2: 280; page 12, lines 1-3.

As recited in dependent claim 13, the invention is further embodied in a system as described above in which the features that appear in the public component link back to the web site. Page 5, lines 27-32.

As recited in dependent claim 14, the invention is further embodied in a system as described above in which the features that appear in the private component link back to the web site. Page 5, lines 27-32.

As recited in dependent claim 15, the invention is further embodied in a method as described above in which the features that appear in the public component link back to the web site. Page 5, lines 27-32.

As recited in dependent claim 16, the invention is further embodied in a method as described above in which the features that appear in the private component link back to the web site. Page 5, lines 27-32.

#### VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

This appeal presents the following issues for decision by the Board:

Whether claims 1, 3, 4, 6 and 7 are anticipated by Fleskes, and are properly rejected on that ground;

Whether claims 8 and 10-12 are anticipated by Fleskes, and are properly rejected on that ground;

Whether claims 2 and 5 are obvious over Fleskes in view of Hickman, and are properly rejected on that ground;

Whether claim 9 is obvious over Fleskes in view of Hickman, and is properly rejected on that ground; and

Whether claims 13-16 are obvious over Fleskes, and are properly rejected on that ground.

## VII. ARGUMENTS

### **I. Claim Rejections - 35 U.S.C. § 102**

Claims 1, 3, 4, 6 and 7 stand rejected under 35 U.S.C. § 102(e) as purportedly being anticipated by Fleskes.<sup>1</sup> Claims 8 and 10-12 stand rejected under 35 U.S.C. § 102(e) as purportedly being anticipated by Fleskes.<sup>2</sup> For the reasons set forth below, Appellants respectfully contend that the rejections are in error and should be reversed. To anticipate a claim, a single prior art reference must disclose each and every feature of the claim.<sup>3</sup> The §102 rejections on appeal are improper because the cited reference does not teach all of the features of the rejected claims.

#### **A. Independent Claims 1 and 8**

Independent claim 1 recites, inter alia, "a web page-forming component for forming the personal web page incorporating one or more of the features of the web site in response to an input provided by the user via the Internet." Claim 8 has a similar limitation. Fleskes fails to disclose, teach or suggest this feature.

The Examiner asserts that:

Fleskes teaches a web page-forming component for forming the personal web page incorporating one or more of the features of the web site in response to an input provided by the user via the Internet, in col. 3, lines 8-17. In the teachings of Fleskes, although the information used to create the web page is stored in a database, it is received as input provided by a user via the Internet and is used to form a web page by incorporating one or more features of the web site such as the models, or predetermined templates provided by the web site.<sup>4</sup>

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<sup>1</sup> Office Action at 4, para. 2.

<sup>2</sup> Office Action at 6, para. 8.

<sup>3</sup> See Gechter v. Davidson, 116 F.3d. 1454, 1457 (Fed. Cir. 1997).

<sup>4</sup> Office Action at 3, para. 2.



However, the text at column 3, lines 7-10 of Fleskes simply states that "web pages [are created] based on models and predetermined templates or designs and incorporation of data about the entity into the web pages." There is no teaching or suggestion that the models and predetermined templates of Fleskes are predetermined features of an Internet web site that can be incorporated into a personal web page.

As discussed in Fleskes, conventional web page development is costly and labor intensive, as web pages require continuous updating and custom design.<sup>5</sup> Fleskes resolves to remedy the deficiencies of the prior art. As illustrated in Figures 2 and 3, Fleskes discloses a system and method, respectively, for generating custom web pages. A login web page is requested from a database in a distributed network. A user who is authorized to view an organization's web page, selects an organization's web site or template. The user enters data about the new organization into the web site or template, and a new web page is generated and displayed having a "similar look and feel" as the viewed organization's web page.<sup>6</sup>

The system and method of Fleskes is different from the system and method of the present invention, as set forth in independent claims 1 and 8. The web page of the present invention is formed by incorporating predetermined features of an Internet web site. In other words, the Internet web site contains the *predetermined* features, and the predetermined features are incorporated into a personal web page using a web page-forming component. The user of the system of the present invention does not select a template resembling another's company web page and then enter data in the selected template. Rather, a user selects one or more predetermined features of an Internet web site and the predetermined features are incorporated in his/her personal web page.

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<sup>5</sup> Fleskes, col. 1, lines 20-55.

<sup>6</sup> Fleskes, col. 8, line 39-col. 9, line 1. See, e.g., Fleskes, col. 2, line 66-col. 3, line 7; col. 24, lines 48-64; col. 25, lines 20-34; and col. 25, line 45-col. 26, line 11.

Fleskes contains no hint or even a remote suggestion of the claimed "web page-forming component." Thus, Fleskes clearly does not anticipate independent claims 1 and 8 since "[a] prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim."<sup>7</sup>

**B. Dependent Claims 3, 4, 6, 7 and 10-12**

Dependent claims 3, 4, 6, 7 and 10-12 depend on at least one of independent claims 1 and 8, and are allowable for at least the same reasons discussed above with respect to independent claims 1 and 8, in addition to the features they recite. For example, dependent claim 3 recites "a single action construction component, wherein the user may add one or more of the web site features to the personal web page with a single action." Dependent claim 10 has a similar limitation. Fleskes fails to disclose, teach or suggest this limitation.

The Examiner avers that this feature is disclosed in column 10, lines 13-16.<sup>8</sup> However, the text relied upon by the Examiner merely describes the process of viewing an item of a web page (e.g., a user clicks on a view button 74 to view an image of the web page). A user cannot add or incorporate one or more predetermined features to or into a personal web page with a single action in the system of Fleskes. To be sure, after a user requests a login page, enters login information and is verified as an authorized user, he/she 1) selects an organization's web site, 2) enters data about an organization into the web site, 3) elects to generate new web pages, 4) is verified as an authorized user to alter the web pages, etc.<sup>9</sup> Surely, the at least four steps are not a single action. Thus, Fleskes does not satisfy this limitation.

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<sup>7</sup> See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997).

<sup>8</sup> Office Action at 5, para. 4.

<sup>9</sup> Fleskes, col. 8, line 47-col. 9, line 2.

Dependent claim 4 recites "an annotation component that allows the user to create and store a comment related to one of the features in the personal web page, such that the comment may be later accessed." Dependent claim 11 has similar limitations. Fleskes does not disclose, teach or suggest these limitations.

The Examiner contends that Fleskes discloses these limitations at column 10, lines 20-23.<sup>10</sup> Although Fleskes describes "optional components such as custom page or image, or a list of comments, and the like," there is no disclosure that the optional components are "related to one of the [predetermined] features in the personal web page." Fleskes must expressly or inherently disclose the limitations of claims 4 and 11 in order to anticipate them. In this case, Fleskes does not and, thus, these limitations are not met.

## **II. Claim Rejections - 35 U.S.C. § 103**

Claims 2 and 5 stand rejected under 35 U.S.C. § 103(a) as purportedly being obvious over Fleskes in view of Hickman.<sup>11</sup> Claim 9 stand rejected under 35 U.S.C. § 103(a) as purportedly being obvious over Fleskes in view of Hickman.<sup>12</sup> Claims 13-16 stand rejected under 35 U.S.C. § 103(a) as purportedly being obvious over Fleskes.<sup>13</sup> For the reasons set forth below, Appellants respectfully contend that the rejections are in error and should be reversed. To establish a prima facie case of obviousness, the Examiner must demonstrate: (1) a suggestion or motivation to combine reference teachings, (2) that there was a reasonable expectation of success, and (3) that prior art

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<sup>10</sup> Office Action at 5, para. 5.

<sup>11</sup> Office Action at 7, para. 2.

<sup>12</sup> Office Action at 9, para. 5.

<sup>13</sup> Office Action at 10, para. 7.

reference or references teach or suggest all claim limitations.<sup>14</sup> Motivation to combine references can come from "the nature of the problem to be solved, the teachings of the prior art, [or] knowledge of persons of ordinary skill in the art."<sup>15</sup> The §103 rejections on appeal are improper because they fail to establish a prima facie case of obviousness in that the cited art does not teach or suggest all elements of claims 2, 5, 9 and 13-16, and, moreover, there is no motivation or suggestion to modify the cited reference(s) in the manner suggested by the Examiner.

**A. Dependent Claims 2, 5 and 9**

The Examiner acknowledges that Fleskes does not disclose "provid[ing] biographical information on the user to be included in the public component,"<sup>16</sup> as recited in claims 2 and 9. Further, the Examiner acknowledges that Fleskes does not disclose "allow[ing] a third party to access the public component from the web site in a single action,"<sup>17</sup> as recited in claim 5. The Examiner asserts that such concepts, however, are demonstrated in Hickman.<sup>18</sup> Claims 2 and 5 depend from independent claim 1, and claim 9 depends from independent claim 8. Fleskes does not teach all elements of independent claims 1 and 8, as demonstrated above, and Hickman does not remedy the shortcomings of Fleskes. Like Fleskes, Hickman fails to teach or suggest Appellants' "web page-forming component for forming the personal web page incorporating one or more of the features of the web site in response to an input provided by the user via the Internet." Appellants furthermore respectfully submit that

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<sup>14</sup> In re Vaeck, 947 F.2d. 488, 493, 20 USPQ2d. 1438 (Fed. Cir. 1991), see also MPEP § 2142, at 2100-128 (Rev. 2, May 2004).

<sup>15</sup> In re Rouffet, 149 F.3d 1350, 1358, 47 USPQ2d 1453 (Fed. Cir. 1998).

<sup>16</sup> Office Action at 8, para. 3; Office Action at 9, para. 6.

<sup>17</sup> Office Action at 8, para. 4.

<sup>18</sup> Id. at para. 3.

claims 2, 5 and 9 are independently patentable because the combination of Fleskes and Hickman is improper.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references."<sup>19</sup> Virtually all inventions are combinations of old elements.<sup>20</sup> If identification of each claimed element in the prior art were sufficient to negate patentability, the Examiner could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.<sup>21</sup> To prevent the use of hindsight based on the teachings of the patent application, the Examiner must show a motivation to combine the references in the manner suggested.<sup>22</sup>

In Rouffet, the Court of Appeals held that although all elements recited in the claims of Rouffet's application were arguably disclosed in the applied prior art references, the rejection under 35 U.S.C. § 103 was improper because there was no suggestion as to why one skilled in the art would have been motivated to combine the references in such a manner as to render the claims obvious.<sup>23</sup>

The situation is, at best, the same in this case. Even if all elements recited in the pending claims can be found in the combined disclosures of Fleskes and Hickman, there is no reason that one of ordinary skill in the art would have been motivated to combine these references in such a manner as to render the pending claims obvious. The Examiner asserts that:

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<sup>19</sup> Rouffet, 47 USPQ2d at 1453; see also MPEP § 2143.01.

<sup>20</sup> See Rouffet, 47 USPQ2d at 1457.

<sup>21</sup> See id.

<sup>22</sup> See id. at 1457-58.

<sup>23</sup> See id. at 1457.

it would have been apparent to a person of ordinary skill in the art, at the time of the present invention, to modify the teachings of Fleskes with Hickman to have the user provide biological information to be included in the public component. This would have allowed the public to verify that the information displayed on the web site is coming from a reliable source.<sup>24</sup>

Further, the Examiner asserts that:

it would have been apparent to a person of ordinary skill in the art, at the time of the present invention, to modify the teachings of Fleskes ... with Hickman to have a third party access the public component from the web site in a single action, or by means of a hyperlink. This would have provided an efficient means for the public to access the public component of the web page.<sup>25</sup>

However, there is no motivation in the cited prior art references to arrive at the claimed invention. The Examiner's purported rationales are merely broad conclusory statements (e.g., this would have allowed the public to verify that information came from a reliable source; this would have provided an efficient means to access the web page). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence.<sup>26</sup> Moreover, combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, the essence of hindsight.<sup>27</sup> Clearly, the Fleskes and Hickman references do not suggest the claimed invention, and there is no sufficient basis for combining the references but for the

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<sup>24</sup> Office Action at 8, para. 3 (citations omitted); Office Action at 9, para. 6 (citations omitted).

<sup>25</sup> Office Action at para. 4 (citations omitted).

<sup>26</sup> See McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d (BNA) 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ (BNA) 209, 217 (CCPA 1977).

<sup>27</sup> See, e.g., Rouffet, 149 F.3d at 1357.

teachings of the present invention, e.g., page 7, lines 1-2 and 18-19.<sup>28</sup> Thus, the proposed modification is no more than a hindsight reliance on the teachings in the present application of the advantages of the present invention.

Accordingly, the combination of Fleskes and Hickman is improper as being impermissibly motivated in hindsight by the teachings of the present application.

**B. Dependent Claims 13-16**

Dependent claims 13 and 15 recite "the features that appear in the public component link back to the web site," and dependent claims 14 and 16 recite "the features that appear in the private component link back to the web site." The Examiner acknowledges that Fleskes do not disclose these limitations.<sup>29</sup> However, the Examiner asserts that "linking back to a web site was well known in the art ... [and t]his concept was often used in web sites by users who requested certain information by clicking on a link in the web site and being relocated from one portion of the web site to another portion of the web site."<sup>30</sup> The Examiner further asserts that "it would have been apparent to a person of ordinary skill ... to modify the teachings of Fleskes ... in order to view certain areas of the web site that the user may have been interested in."<sup>31</sup> These assertions, however, are without merit.

Claims 13-16 depend from at least one of independent claims 1 and 8, and are patentable for at least the same reasons discussed above with respect to claims 1 and 8. Moreover, claims 13-16 are independently patentable because Fleskes fails to teach or suggest additional features recited in claims 13-16.

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<sup>28</sup> Each citation refers to published information such as a list of "reliable sources."

<sup>29</sup> Office Action at 10, para. 8.

<sup>30</sup> Id.

<sup>31</sup> Id.

Claims 13-16 specifically recite that the predetermined features of the Internet web site that are incorporated into a personal web page, must link back to that Internet web site. For example, if a personal web page includes features A and B, which were contained on the Internet web site, those features (e.g., A and B) will link back to the original Internet web site. No where does Fleskes disclose this limitation. At most, Fleskes describes entering arbitrary web addresses and hyper-linking to other web sites.<sup>32</sup> This is not analogous to having features that link back to an original web site that contained the features.

Finally, it would not have been obvious to a skilled artisan to modify Fleskes to link back to a web site that contained features because, in the system of Fleskes, a web page is not formed by incorporating predetermined features of an Internet web site and, thus, there is nothing to link back to. Moreover, there is no valid motivation for modifying Fleskes in the manner suggested to derive the subject matter of claims 13-16. Accordingly, the proposed modification of Fleskes is improperly motivated by hindsight reliance on Appellants' disclosure. Further, "view[ing] certain areas of the web site that the user may have been interested in" is not a limitation of claims 13-16 (or any claim of the present invention).

For the forgoing reasons, Appellants respectfully request that the Board reverse all outstanding rejections of the claims of this application.

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<sup>32</sup> Fleskes, col. 11, lines 15-22.

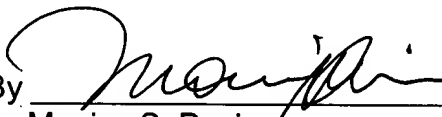


CONTINGENT AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT AND  
CONTINGENT PETITION FOR EXTENSION OF TIME

Unless a check for the present Brief on Appeal is submitted herewith for the fee required under 37 C.F.R. §§1.192(a) and 1.17(c), please charge said fee to Deposit Account No. 02-2135.

Appellants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 02-2135.

Respectfully submitted,

By  \_\_\_\_\_

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Date: January 18, 2005

APPENDIX A

**CLAIMS 1-16:**

1. A system for allowing a user to customize a personal web page using an Internet web site having predetermined features that can be incorporated into the personal web page, the system comprising:

a server that is connected to the Internet and that controls the web site; and

a web page-forming component for forming the personal web page incorporating one or more of the features of the web site in response to an input provided by the user via the Internet, said personal web page comprising a private component accessible only by the user and a public component accessible to anyone, wherein the user's input determines which of the features appear in the private component and which of the features appear in the public component.

2. The system of claim 1 wherein the input further provides biographical information on the user to be included in the public component.

3. The system of claim 1 further comprising a single action construction component, wherein the user may add one or more of the web site features to the personal web page with a single action.

4. The system of claim 1 further comprising an annotation component that allows the user to create and store a comment related to one of the features in the personal web page, such that the comment may be later accessed.

5. The system of claim 1, wherein the server allows a third party to access the public component from the web site in a single action.

6. The system of claim 1 wherein the web page-forming component further comprises a construction component to guide the user through the formation of the personal site.

7. The system of claim 1 further comprising a tracking component that changes the personal web page to reflect changes in the web site.

8. A method for allowing a user to customize an Internet web site having particular features, the method comprising the steps of:

providing access to a web site via a server;

in response to receiving an input to the website, providing a web page-forming component for forming a personal web page incorporating one or more of the web site features in accordance with the input, said personal web page comprising a private component accessible only by the user and a public component accessible to anyone, wherein the input determines which of the features appear in the private component and which of the features appears in the public component.

9. The method of claim 8 further comprising providing biographical information to be included in the public component.

10. The method of claim 8 further comprising adding one of the web site features to the personal web page with a single action.

11. The method of claim 8 further comprising the steps of:  
creating an annotation related to one of the features in the personal web page;  
storing said annotation; and  
accessing said annotation during subsequent use of the personal web page.

12. The method of claim 8 further comprising the step of automatically updating the personal web page.

13. The system of claim 1, wherein the features that appear in the public component link back to the web site.

14. The system of claim 1, wherein the features that appear in the private component link back to the web site.

15. The method of claim 8, wherein the features that appear in the public component link back to the web site.

16. The method of claim 8, wherein the features that appear in the private component link back to the web site.

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## APPENDIX B

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Serial Appln. No. 09/734,043

## APPENDIX C

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